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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,212	09/08/2003	Tadakatsu Nabeya	242547US3	7495
22850	7590	03/14/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			RACHUBA, MAURINA T	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/656,212	Applicant(s) NABEYA, TADAKATSU	
	Examiner M Rachuba	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 February 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preston 6,196,911 in view of Breivogel et al, 5,547,417. '91 1 discloses the claimed invention (please refer to columns 4, lines 50 through column 7, lines 34) except for the use of adjusters to adjust the difference in height with respect to the dressing face between reference planes. .417, in a similar device, figure 2a, teaches the use of adjusters 236 provided in recesses provided in the base metal such that bases of the adjusters are movable within the recesses, attached to abrasive grit tips, the adjusters serving to adjust a difference in height with respect to the dressing face between reference planes of the grit tips, the reference planes each being defined by the end of

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the abrasive grit in the tip; the adjusters include bases different from the base metal, and the abrasive unit having the adjuster are bonded on the base and are arranged in a ring manner on the dressing face along an outer region of the base metal. It would have been obvious to one of ordinary skill to have provided '911 with the adjusters taught by '417, column 5, lines 35- 60, to allow for uneven wear or the replacement of the abrasive segments. Further, regarding claim 10, as '417 teaches that the adjusters are independently adjustable, any of the segments of '417 inherently can be higher, or lower, than any other segment. It would have been obvious to one of ordinary skill in the art to have provided '911 with the independently adjustable means of '417, to make any of the segments of '911 higher or lower than the other segments, to adjust for variations in the pad surface. Regarding claim 11, please refer to the previous actions rejection of claim 1.

Response to Arguments

4. Applicant's arguments filed 21 February 2006 have been fully considered but they are not persuasive. Applicant seems to be arguing that no one reference teaches applicant's claimed invention. Applicant is arguing that Preston does not disclose or teach adjusters and Breivogel does not disclose or teach bases on which abrasive grain units are disposed. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has not provided any evidence as to why one of

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ordinary skill would not be motivated to provide Preston with the teachings of Breivogel. As set forth in the rejection above, it is the examiner's position that Preston discloses the conditioning unit as claimed by applicant except for the adjusters, and that one of ordinary skill would have considered it obvious to have provided Preston with the adjusters taught by Breivogel, to allow the dressing tool surface to be adjusted for height relative to the dressing tool base, or to replace the abrasive units when required.

The examiner fails to understand how, in adjusting the shanks to vary a depth of groove, the adjusters are not also "serving to adjust the difference in height with respect to the dressing face between reference planes of the respective abrasive grain units, the reference planes each being defined by ends of the abrasive grains in the corresponding abrasive grain units." As the threaded shanks of '417 adjust the conditioning block surface, and the distance between the dressing block surface and the tip of the shank, it is the examiner's position that '911, as modified by '417, makes obvious applicant's claimed invention. That applicant has another reason for adjusting the height of the abrasive units is moot, as the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

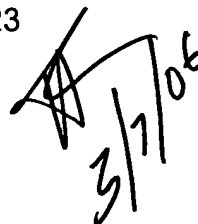
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Rachuba whose telephone number is 571-272-4493. The examiner can normally be reached on Monday-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M Rachuba
Primary Examiner
Art Unit 3723

Handwritten signature and date 3/1/06.